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Filing date: **06/23/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215637
Party	Defendant Pro-Mart Industries, Inc.
Correspondence Address	LOWELL ANDERSON STETINA BRUNDA GARRED & BRUCKER 75 ENTERPRISE , SUITE 250 ALISO VIEJO, CA 92656-2681 UNITED STATES opposition@stetinalaw.com, landerson@stetinalaw.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Lowell Anderson
Filer's e-mail	opposition@stetinalaw.com, landerson@stetinalaw.com
Signature	/Lowell Anderson/
Date	06/23/2015
Attachments	MotionToDismiss.Final.pdf(60474 bytes) Decl Anderson.MTD.pdf(23086 bytes) Ex1-New.pdf(658430 bytes) Ex2-New.pdf(497951 bytes) Ex3-new.pdf(657372 bytes) Ex4-New.pdf(498012 bytes)

Case: PROMT-169T2M
Trademark Application

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
IN RE SERIAL NO. 86/124,372

MSC Services Corp. and Sid Tool Co., Inc.)	Opposition No.: 91215637
dba MSC Industrial Supply Co.)	
)	
Opposer,)	
)	
vs.)	
)	
Pro-Mart Industries, Inc.)	
)	
Applicant)	

MOTION TO DISMISS AND MOTION TO STRIKE UNDER FED.R.CIV.P 12

I. INTRODUCTION & SUMMARY

Applicant cannot identify the basis on which each of its five classes of goods are opposed and believes at least some of the Applicant's goods and classes are so different from Opposer's goods and classes that given the differences in the marks no likelihood of confusion can be pled by plausible facts. Unspecified common law uses and "famous" marks are also not tied to any specific goods or class of goods in the application, and two asserted ITU applications have been abandoned. As there are two Opposers, the rights asserted by each Oppose are unclear and not established. The standing of a licensee to assert rights under six ITU applications (two of which are abandoned) and under common-law rights for which no use by licensee is alleged, are insufficiently pled for each of the Applicant's five classes of goods. Thus, dismissal under Fed.R.Civ.P. 12(b)(6) for failure to state a claim is requested.

Applicant Pro-Mart Industries, Inc. ("Applicant") filed a multi-class application in five classes, classes 6 (e.g., metal bins, boxes & hooks), 12 (e.g., carts), 20 (e.g., shelves, racks, & hangers), 21 (e.g., housewares) and 22 (e.g., laundry bags).

The Opposition is based on six applications in classes that do not overlap with Applicant's classes, for very different goods, with two of the applications now abandoned. Opposer's six applications include class 6 (metal building materials, hardware, storage containers), 8 (jacks & hand tools), class 11 (lighting fixtures, heaters & valves – now abandoned), class 17 (non-metallic hoses and plastic pipes - now registered), class 18 ("tool bags sold empty"), class 22 (ropes, slings & tie-downs – now abandoned). Of the three non-abandoned ITU applications and one registration relied on in the application, only one has a class found in the opposed Application, class 6 and that

application contains different goods, such as metal building materials, wires and pipes. Finally, the ITU applications relied on in Opposition ¶ 4 & 5 for goods in classes 11 and 22 are no longer at issue as the applications were abandoned for failure to file a statement of use and no actual use of any specific goods in either class is pled. Exhs. 1-4, to Anderson Decl.

Opposer has not identified which of its five applications or registrations are alleged to create a likelihood of confusion with Applicant's various classes. For example, Opposer's "tool bags sold empty" in class 18 appear to bear no similarity in product overlap or channel of distribution with Applicant's metal bins, boxes and hooks in class 6, with the carts and racks in class 12, with the shelves, racks and hangers in class 20, with the housewares in class 21, or the laundry bags in class 22. Without sufficiently related goods no confusion is likely and the claims may be dismissed – especially when the marks are different. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related).

Applicant maintains that the goods in its application are so different from Opposer's "tool bags sold empty" in class 18 that even if the marks were the same a likelihood of confusion could not be plausibly pled as to some, if not all of the above classes and the Applicant's goods therein. The differences in the marks make it more implausible that a likelihood of confusion exists. But more significantly, Applicant should not have to guess or speculate which of applications/registrations and goods are alleged to cause the likelihood of confusion with each of Applicant's classes, nor should Applicant have to argue for dismissal of claims based on goods, registrations and

applications which are not alleged to cause a likelihood of confusion. Dismiss for failure to state a claim is thus requested. A more detailed explanation follows.

II. LEGAL STANDARDS FOR 12(b)(6) & 12(f) MOTIONS

The Federal Rules of Civil Procedure govern the present motions. 37 C.F.R. § 2.116 (a). A complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” fail to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555). *Accent Packaging Inc. v. Leggett & Platt Inc.*, 707 F3d 1318, 105 USPQ2d 1745 (Fed. Cir. 2013) (affirming dismissal of trade secret claims that were not plausible on their face – quoting *Iqbal* and *Twombly*.).

III. STANDING

Standing requires a “claim of likelihood of confusion that is not wholly without merit.” TBMP309.03(b). Opposer must also plead facts establishing or reasonably inferring a real interest in the proceedings.

As discussed below, Applicant cannot tell which application’s classes of goods are the alleged basis for opposing each of the five classes in the disputed multi-class application let alone any specific products. Thus, Applicant cannot evaluate the standing of the owner of the asserted applications, MSC Services Corp. The Opposer has the burden of pleading plausible facts establishing its standing and that has not been done.

Applicant also disputes the standing of the non-exclusive licensee of an ITU application, Sid Tool Co., Inc., as insufficient facts are alleged to establish standing.

There is a conclusory allegation of use of unspecified goods in Opposition ¶ 2 and allegations that Sid Tool “is a licensee of” each of the six asserted applications. Opp. ¶¶ 4-9. All of Opposers’ applications in ¶¶ 4-9 are intent to use applications. No allegation is made in the pleadings that a statement of use has been filed for any of them or that Sid Tool has any use based rights relevant to each of the five disputed classes of Applicant’s application.

The conclusory allegations of Opposition ¶2 do not state plausible facts from which standing may be inferred as to any of the five classes of goods in the disputed Application, let alone as to each class of goods in the application. Indeed, no specific goods are identified as being used nor is any application or goods within the application identified as establishing plausible facts on which to infer a claim with any merit as to likelihood of confusion as to each of the five classes of goods in the disputed Application.

Further, the non-exclusive licensee of an ITU application has hypothetical rights at best, as reflected by the abandonment of the asserted applications in Opposition ¶¶ 4 and 5 which were abandoned for failure to file a statement of use. Ex. 1-4 to Anderson Decl. As those abandoned applications provide no basis for the Opposition, the need for pleading plausible facts establishing prior use is especially apt, as is the need for more than unspecified, non-exclusive rights in an application specifying goods that may never be used.

The current allegations are insufficient to establish standing for Sid Tool, and insufficient to both Opposers as to at least some of the classes with very different goods. Dismissal is requested. Applicant recognizes the dismissal will likely be with leave to

amend but the pleading of further plausible facts are needed to evaluate whether standing exists and whether further motions are appropriate.

IV. THE DEFECTIVE ALLEGATIONS

Opposition ¶1 alleges both Opposers “market, distribute and sell a variety of products under the mark WORDSMART, including containers, tool boxes, storage furniture, storage systems, tool cabinets, shelving systems, carts and cart accessories, bags, tools workstations, safety supplies and MRO Products [maintenance, repair and operations products]”. The allegation fails to allege prior rights in such sales.

Further, allegations of MRO products, defined as “maintenance, repair and operations” products are vague and impermissibly ambiguous as they provide little or no basis to evaluate whether there is a plausible basis for likelihood of confusion.

Safety supplies are also vague and impermissibly ambiguous and insufficient. None of the identified goods are said to be confusingly similar to any one or more of the goods in any of the 5 classes in the Application being opposed so as to establish a plausible basis for likelihood of confusion.

Opposition ¶2 says each of the Opposers has made continuous use of WORKSMART since Feb. 2010, but no goods are specified, and no goods are correlated to any sufficiently similar goods in each of the 5 classes in the opposed Application so as to establish a plausible factual basis for a likelihood of confusion or as to enable evaluation of a likelihood of confusion to form a responsive pleading.

Opposition ¶3 makes conclusory allegations that the Opposers’ mark has common law rights and is famous. But no specific goods are identified for which the mark is famous, no plausible basis for alleged use or fame is provided, no plausible basis

for establishing use or fame in connection with specific products is provided, and neither the common law rights nor the “famous” mark in connection with any specific goods is are correlated to any sufficiently similar goods in each of the 5 classes in the Application so as to provide a plausible factual basis for a likelihood of confusion or as to enable evaluation of a likelihood of confusion. Threadbare assertions supported by mere conclusory statements fail to state a claim plausible. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949.

Opposition ¶¶4-9 allege that Opposer MSC Services owns applications for various goods in classes 22, 11, 17, 8, 6 and 18, respectively, and says Opposer Sid Tool is a licensee. But no specific goods are identified, and no goods are correlated to any sufficiently similar goods in each of the 5 classes in the Application so as to provide a plausible factual basis for a likelihood of confusion or as to enable evaluation of a likelihood of confusion or of standing by Sid Tool.

Opposition ¶¶ 4 and 5 are demonstrably false as application 77968707 for goods in Class 22 was abandoned for failing to file a statement of use. Ex. 3-4 to Anderson Decl. Likewise, application 77968529 for goods in Class 11 was abandoned for failing to file a statement of use. *Id.* at Ex. 1-2. Neither application provides any basis for opposition, yet the goods in each of Applicant’s 5 classes are sought to be rejected based on those abandoned applications. The abandoned applications should be removed from the Opposition.

Opposition ¶ 12 makes conclusory allegations of superior rights in products “that are substantially similar and/or related to the goods and services listed in the Opposed Application.” But no plausible facts are identified to support the conclusion nor are any

specific goods in any of Applicant's 5 classes of goods identified as being related to substantially to any specific goods of either Opposer. Threadbare assertions supported by mere conclusory statements fail to state a claim plausible. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949.

Opposition ¶13 makes a conclusory claim of use-based rights superior to Applicant. But no plausible facts are identified to support the conclusion nor are any specific goods of Opposer identified for which it claims prior rights exist, nor are those non-existent uses for specific goods correlated to any of Applicant's 5 classes of goods, for either Opposer.

Opposition ¶ 14 makes conclusory allegations of a likelihood of confusion if Applicant's application and its 5 classes of goods are not withdrawn. But it provides no plausible facts on which to base the conclusion or to identify any basis for finding a likelihood of confusion as to any goods within each of the Applicant's 5 classes of goods, for either Opposer. Threadbare assertions supported by mere conclusory statements fail to state a claim plausible. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949.

Opposition ¶ 15 makes a conclusory allegation of serious harm to Opposers. But no plausible facts are identified as to how each Opposer would be harmed, especially regarding the licensee of an ITU application.

As no allegation is made that the Opposers' mark was actually used on goods before the filing of Applicant's application, no actual use is pled with plausible facts. No actual use is pled with sufficient specificity to warrant dismissal of any goods in each of Applicant's 5 classes.

As no specific goods are identified as being sufficiently similar to any corresponding goods in each of Applicant's 5 classes, no plausible facts are pled on which to support a basis for opposition.

Applicant should not have to guess and speculate as to which goods in which of Opposers' six applications are alleged to cause a likelihood of confusion in each of its 5 classes, especially when two of those asserted applications have been abandoned for failure to file a statement of use.

The Opposers have made conclusory allegations on several of the elements needed for relief. But "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," fail to state a claim plausible on its face. *Iqbal*, 129 S. Ct. at 1449. Threadbare assertions supported by mere conclusory statements fail to state a claim plausible.

V. CONCLUSION

Dismissal of the Opposition for failure to state plausible facts on which relief can be granted as to each of the 5 class of goods opposed, is respectfully requested.

Respectfully submitted,

STETINA BRUNDA GARRED & BRUCKER

Dated: June 23, 2015

By: /Lowell Anderson/

Lowell Anderson, Reg. No. 30,990
75 Enterprise, Suite 250
Aliso Viejo, CA 92656
(949) 855-1246
Counsel for Applicant

PROOF OF SERVICE

State of California)
) ss.
County of Orange)

I am over the age of 18 and not a party to the within action; my business address is 75 Enterprise, Suite 250, Aliso Viejo, California 92656. On **June 23, 2015**, the attached **MOTION TO DISMISS AND MOTION TO STRIKE UNDER FED. R. CIV. P. 12** was served on all interested parties in this action by U.S. Mail, postage prepaid, at the address as follows:

Michael R. Graif
Curtis, Mallet-Prevost, Colt & Mosle LLP
101 Park Avenue
New York, NY 10178

Executed on **June 23, 2015** at Aliso Viejo, California. I declare under penalty of perjury that the above is true and correct. I declare that I am employed in the office of STETINA BRUNDA GARRED & BRUCKER at whose direction service was made.

/Tara Hamilton/
Tara Hamilton

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
IN RE SERIAL NO. 85926917

MSC Services Corp. and Sid Tool Co., Inc.)	Opposition No.: 91215637
dba MSC Industrial Supply Co.)	
)	
Opposer,)	
)	
vs.)	
)	
Pro-Mart Industries, Inc.)	
)	
Applicant)	

DECLARATION OF LOWELL ANDERSON RE MOTION TO DISMISS UNDER
FED.R.CIV.P 12

I, Lowell Anderson, declare as follows:

1. I am the attorney of record for Applicant PRO-Mart Industries, Inc.in the above identified trademark application.
2. Attached as Exhibit 1 is a true and correct copy of a printout from the TESS database which I printed June 23, 2015 for application 77968529 for WORKSMART in International Class 11, stating the application is abandoned.
3. Attached as Exhibit 2 is a true and correct copy of a printout from the TSDR database which I printed June 23, 2015 for application 77968529 for WORKSMART in International Class 11, stating the current status of the application is

“Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was Issued.”

4. Attached as Exhibit 3 is a true and correct copy of a printout from the TESS database which I printed June 23, 2015 for application 77968707 for WORKSMART in International Class 22, stating the application is abandoned.

5. Attached as Exhibit 4 is a true and correct copy of a printout from the TSDR database which I printed June 23, 2015 for application 77968707 for WORKSMART in International Class 22 stating the current status of the application is “Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was Issued.”

The undersigned, being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true, and that this Declaration is being executed on June 23, 2015, at Aliso Viejo, California.

Dated: June 23, 2015

By: Lowell Anderson/

Lowell Anderson

Counsel for Applicant

PROOF OF SERVICE

State of California)
) ss.
County of Orange)

I am over the age of 18 and not a party to the within action; my business address is 75 Enterprise, Suite 250, Aliso Viejo, California 92656. On **June 23, 2015**, the attached **DECLARATION OF LOWELL ANDERSON RE MOTION TO DISMISS UNDER FED. R. CIV. P. 12** was served on all interested parties in this action by U.S. Mail, postage prepaid, at the address as follows:

Michael R. Graif
Curtis, Mallet-Prevost, Colt & Mosle LLP
101 Park Avenue
New York, NY 10178

Executed on **June 23, 2015** at Aliso Viejo, California. I declare under penalty of perjury that the above is true and correct. I declare that I am employed in the office of STETINA BRUNDA GARRED & BRUCKER at whose direction service was made.

/Tara Hamilton/
Tara Hamilton


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WORKSMART

Word Mark	WORKSMART
Goods and Services	(ABANDONED) IC 011. US 013 021 023 031 034. G & S: Lighting fixtures, lighting tracks, heating installations, electric space heaters, ventilating exhaust fan, ventilating fans for commercial and industrial use, ventilating louvers and water conditioning units and pipes sold as a unit with the water closets and water conditioning units; reinforcements for water-pipes, namely, shower control valves, tub control valves, plumbing fittings, namely, bibs, cocks, traps, couplers, drains, valves and spouts
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77968529
Filing Date	March 25, 2010
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	January 11, 2011
Owner	(APPLICANT) MSC Services Corp. CORPORATION NEW YORK 75 Maxess Road Melville NEW YORK 11747
Attorney of Record	Michael R. Graif
Type of Mark	TRADEMARK
Register	PRINCIPAL

Live/Dead Indicator
Abandonment Date

DEAD
April 14, 2014

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Mark: WORKSMART

WORKSMART

US Serial Number: 77968529

Application Filing Date: Mar. 25, 2010

Register: Principal

Mark Type: Trademark

Status: Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance w
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Status Date: Apr. 14, 2014

Publication Date: Jan. 11, 2011

Notice of Allowance Date: Mar. 08, 2011

Date Abandoned: Apr. 14, 2014

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WORKSMART

Word Mark

WORKSMART

Goods and Services

(ABANDONED) IC 022. US 001 002 007 019 022 042 050. G & S: Ropes and cords for lifting and securing loads, namely, non-metal belts, webbings, lifting bands, ropes, nets, non-metal lifting slings, raising bands as well as parts thereof sold as a unit with the goods; bands made of canvas for lifting and securing loads

Standard Characters Claimed
Mark Drawing Code

(4) STANDARD CHARACTER MARK

Serial Number

77968707

Filing Date

March 25, 2010

Current Basis

1B

Original Filing Basis

1B

Published for Opposition

January 11, 2011

Owner

(APPLICANT) MSC Services Corp. CORPORATION NEW YORK 75 Maxess Road Melville NEW YORK 11747

Attorney of Record

Michael R. Graif

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator
Abandonment Date

DEAD
March 11, 2014

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Mark: WORKSMART

WORKSMART

US Serial Number: 77968707

Application Filing Date: Mar. 25, 2010

Register: Principal

Mark Type: Trademark

Status: Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance w
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Status Date: Mar. 11, 2014

Publication Date: Jan. 11, 2011

Notice of Allowance Date: Mar. 08, 2011

Date Abandoned: Mar. 11, 2014

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